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EXAMINER

HARAN, JOHN T

ART UNIT PAPER NUMBER

1733

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/926,174

Applicant(s)

RUCKMANN ET AL.

Examiner

John T. Haran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-62 is/are pending in the application.
- 4a) Of the above claim(s) 36-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9/19/01. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group 1, Species A: claims 33-35 in Paper mailed on 10/31/03 is acknowledged.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 9/19/01 has been considered by the examiner.

It is noted that DE 1189562 and DE 1273483 have not been considered because no copy was filed and the examiner was unable to obtain a copy or an English language abstract.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 33-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is first noted that claims 33-35 are not original claims and were part of a preliminary amendment filed on 4/2/02 (after the filing of the application on 1/7/02).

Claim 33 requires the step of "separating said plurality of paper webs from each other after accomplishing said drawing in of said plurality of paper webs wherein said plurality of paper webs are fastened to each other only during said drawing in". There is insufficient description in the specification of the nexus and distinction between the fastening of the paper webs, the drawing in process, the folding in the longitudinal folding hopper, and the separating of the fastened together paper webs.

The drawing in process is not adequately defined because there is no indication what constitutes the start and finish of the drawing in process. It appears that the drawing in process starts when the holding device (spikes) secure the paper webs and ends when the paper webs are removed from the holding device (spikes) (See Figure 1). However, the paper webs are fastened together, for example with adhesive, prior to being secured to the holding device (pierced by the spikes) and the start of the drawing in process (See Figure 14). Consequently there appears to be no support for the paper webs being fastened to each other **only** during the drawing in process. Original claim 2 states that the "paper webs are exclusively connected with each other during the drawing in process and are not connected with each other during production". This does not provide support for the paper webs being fastened together only during the drawing in process. The abstract mentions that "the paper webs or their starting ends can be secured together only for the purpose of being fed through the longitudinal fold former", however it does not provide support for the paper webs only being fastened together during the drawing in process. Requiring the paper webs to be fastened to each other only during the drawing in process constitutes new matter because the original

specification does not convey to one of ordinary skill in the art that applicant had possession of this feature at the time the application was filed. Additionally if the drawing in process is intended to include the fastening of the paper webs together it was not adequately described as such in the original specification to convey to one of ordinary skill in the art at the time the application was filed that the drawing in process was adequately defined to include the fastening of the paper webs together.

Additionally the relation between the separating of the plurality of fastened paper webs from each other, the drawing in process, and the folding of the paper webs is not adequately described in the specification. Original claim 2 provides support for the fastened together paper webs being connected (fastened) together during the drawing in process and not being connected (fastened) together during production. However this does not clarify matters because the term production is indefinite (what constitutes production?) and there is no indication when the paper webs are separated from one another. The lack of a definition of the drawing in process compounds the problem because the drawing in process is not adequately described. Does the drawing-in process include folding by the rollers (26,27) or is folding by the rollers considered part of production? Also are the fastened together paper webs separated from one another after removal from the holding device and prior to the folding rollers or at some point after the folding rollers? In either instance the original specification does not provide any description of separating the fastened together paper webs from one another either after removal of the paper webs from the holding device of the draw in device and before the folding rollers or for separating the fastened together paper webs from one

another after the folding rollers. It appears that requiring the paper webs to be separated from one another after accomplishing the drawing in process in combination with the requirement that the paper webs only be fastened to one another during the drawing in process constitutes new matter because the original specification does not convey to one of ordinary skill in the art that applicant had possession of separating the webs from one another after accomplishing the drawing in process so that the paper webs are only fastened to one another during the drawing in process at the time the application was filed.

It is also noted that the paragraph spanning pages 7 and 8 of the original specification (paragraph 058 of the substitute specification) provides the only description of a "separation" in the specification. It states "In the final phase of the draw-in process, the paper webs, or the train, are separated from the paper web front fastenings, which respectively hold them. Such a separating device, not represented, consists for example of a rotating top and bottom cutter, between which the paper webs/train are drawn. After cutting of the paper web fronts, or train fronts, the finite draw-in chains are conducted into a storage device in guide rails fixed to the frame". This text is worded confusingly, however it appears that it is not referring to separating the fastened together paper webs from one another, but rather separating the paper webs from the holding device of the paper web draw-in device, namely the spikes, by cutting the paper webs along both side edges to separate the paper webs from the holding device. It appears that possibly applicant intended to separate the plurality of paper webs from the holding device after accomplishing said drawing in of said plurality

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of paper webs wherein the plurality of paper webs are fastened to the holding device only during said drawing in.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 is indefinite because it is based upon a confusing specification. It is unclear what the drawing in process is intended to encompass. When does it start and end? The drawing in process appears to start when the plurality of paper webs are secured to the holding device (spikes) and end when the paper webs are removed from the holding device. But if that is the case, then it is unclear how the paper webs can only be fastened to one another during the drawing in process when they are fastened together prior to being secured to the holding device (See Figure 14). Is the drawing in process intended to include the fastening together of the paper webs? Also it is unclear when the separating of the paper webs from one another actually occurs because it is unclear what the drawing in process is intended to encompass. Does the drawing in process include folding by the folding rollers (26,27)? Are the fastened together paper webs separated from one another upon removal from the holding device or after the folding by the folding rollers or at some other point? Clarification is requested.

Claim 34 is indefinite because it is confusing. Are the paper web starts connected to already drawn in paper webs to form a paper train of the same thickness as the already drawn in paper webs or a different thickness, i.e. are the paper web starts butt joined to the end of already drawn in paper webs or are they layered on top of the already drawn in paper web to form a higher/thicker stack of paper webs?

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fischer (U.S. Patent 4,619,449) is directed to a method for folding superposed paper webs wherein a plurality of paper webs are secured to a holding device, consisting of spikes, of a draw in device that draws the webs to a longitudinal folding former in order to prevent buckling, creasing or tearing of the webs of the folding former (See Figure 2; Column 1, lines 58-64; Column 2, lines 36-48).

CH 342241 is directed to a method of folding a plurality of superposed paper webs that are secured to a holding device, consisting of spikes, of a draw in device that draws the webs to a longitudinal folding hopper (See Figures, oral translation from PTO translator).

DE 2754179 is directed to a method of folding a plurality of paper webs wherein the edges of the paper webs are electrostatically charged so that the edges of the superposed webs will adhere together in order to prevent damage to the webs during processing. The adhered (fastened) webs are fed to a longitudinal folding hopper

where the adhered webs are longitudinally folded and are subsequently separated from one another (See Figures, oral translation from PTO translator).

It is noted that there is ample motivation to modify Fischer or CH 342241 to have the paper webs fastened together during the drawing in process as suggested in DE 2754179, however such a combination fails to meet all the limitations of claim 33, as currently worded, because there is no suggestion of having the paper webs fastened together **only** during the drawing in process. Such a combination could render claim 33 obvious depending upon how the claim is amended to overcome the 35 USC 112, 1st paragraph description problems and 2nd paragraph indefiniteness problems.

Michalik et al (U.S. Patent 5,503,379) is cited for its applicability to claim 34 for connecting paper web starts to already drawn in paper webs (See Figure 3).

Honegger (U.S. Patent 5,961,758) is cited for its applicability to claim 35 for teaching fastening paper webs together with adhesive prior to folding (See Figure 2).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John T. Haran** whose telephone number is **(703) 305-0052 or (571) 272-1217 as of 12/19/03**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

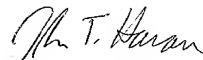
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in cursive script, reading "John T. Haran".

John T. Haran
Examiner
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